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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
FORD, VANESSA L	

ART UNIT	PAPER NUMBER
1645	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,210

Applicant(s)

LACOUR ET AL.

Examiner

Vanessa L. Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Election/Restriction

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

2. Claims 10 and 11 are drawn to a non-statutory invention under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). In the event that claims 10 and 11 are amended to fall within one of the Groups of inventions set forth below, the claim(s) will be added to the appropriate Group. If the claims are amended to an invention other than an invention set forth in the Groups below, the claim(s) will be withdrawn.

Consequently, only claims 1-9 and 12-22 are included in the restriction requirement set forth below.

- Group I Claims 1-8, 13 and 16 are drawn to a plasmid vector comprising an origin of replication, a selection marker, a promoter and a nucleic acid sequence. Further species election required.
- Group II Claim 9 is drawn to selective marker. Further species election required.
- Group III Claim 12 is drawn to a plasmid vector comprising a selective marker comprising a nucleic acid sequence encoding a polyketide synthetase fragment. Further species election required.
- Group IV Claims 14 and 15 are drawn to an expression cassette and plasmid vector. Further species election required.
- Group V Claims 17 is drawn to a method for transforming filamentous fungi. Further species election required.
- Group VI Claim 18 is drawn to an expression cassette comprising a promoter sequence in functional linkage with a nucleic acid sequence. Further species election required.
- Group VII Claims 19-22 are drawn to a method for transforming filamentous fungi. Further species election required.

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In the event that Applicant elects Groups I, V, and VII, Applicant asked to elected one corresponding sequence (SEQ ID NO.) to examined with the above elected invention. Applicant must elect:

Species A, SEQ: 1

Species B, SEQ: 2

Species C, SEQ: 3

Species D, SEQ: 4

Species E, SEQ: 5

Species F, SEQ: 6

Species G, SEQ: 7

Species H, SEQ: 8

Species I, SEQ: 9

Species J, SEQ: 10

Species K, SEQ: 11

Species L, SEQ: 12

Species N, SEQ: 13

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In the event that Applicant elects Groups II and IV, Applicant asked to elected one corresponding sequence (SEQ ID NO.) to examined with the above elected invention. Applicant must elect:

Species A, SEQ: 1

Species B, SEQ: 2

Species C, SEQ: 3

Species D, SEQ: 4

Species E, SEQ: 5

Species F, SEQ: 6

Species G, SEQ: 7

Species H, SEQ: 8

In the event that Applicant elects Group III, Applicant asked to elected one corresponding sequence (SEQ ID NO.) to examined with the above elected invention.

Applicant must elect:

Species A, SEQ: 6

Species B, SEQ: 8

Species C, SEQ: 9

Species D, SEQ: 10

Species E, SEQ: 11

Species F, SEQ: 12

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Species G, SEQ: 13

In the event that Applicant elects Group VI, Applicant asked to elected one corresponding sequence (SEQ ID NO.) to examined with the above elected invention.

Applicant must elect:

Species A, SEQ: 3

Species B, SEQ: 4

Species C, SEQ: 5

Species D, SEQ: 6

Species E, SEQ: 9

Species F, SEQ: 10

Species G, SEQ: 11

Species H, SEQ: 12

Species I, SEQ: 13

3. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I lacks novelty under PCT Article 33(2) as being anticipated by Tsai et al., (*Journal of Bacteriology*, June 1998, p. 3031-3038) disclose an integration vector pRGD12 for filamentous *Aspergillus fumigatus* in the alb1 polyketide synthetase gene. The vector is used for transformation is pBC-KS with a 2.8 kbp hph cassette from pAN7-

1 which has a gdp promoter and trpC terminator. Group I is the main invention in this application and it lacks novelty, therefore the other claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See


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"Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa L. Ford whose telephone number is (571) 272-0857. The examiner can normally be reached on 9 am- 6 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571.272.0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Vanessa L. Ford
Biotechnology Patent Examiner
May 29, 2007


JEFFREY SIEW
SUPERVISORY PATENT EXAMINER